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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,570	12/17/2001	Sharon Schwartz	P00021902X	2702
27689	7590	03/30/2005	EXAMINER	
JOHN C. SMITH, ESQ. 4800 NORTH FEDERAL HIGHWAY SUITE A-207 BOCA RATON, FL 33431			PERRIN, JOSEPH L	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/023,570	<b>Applicant(s)</b> SCHWARTZ, SHARON	
	<b>Examiner</b> Joseph L. Perrin, Ph.D.	<b>Art Unit</b> 1746	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 16-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 February 2005 has been entered.

### ***Response to Arguments***

2. In view of applicant's amendment filed 22 February 2005 and arguments filed 18 January 2005, the status of the application is as follows:

### ***35 U.S.C. §102(b) Rejections over Nygren***

The rejection of claims 1-9 are maintained for reasons set forth below.

Applicant argues that that the claims have been amended to add structural limitations which do not appear in Nygren, specifically the "separate purpose" of the nozzles and how the holding devices are "designed to hold" specific components. This is not persuasive because the purpose of the nozzles and whether or not the holding devices hold an "assembled object" or "disassembled object" are intended use and do not provide any further structural limitation to the

claimed apparatus. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the instant case, applicant argues the process in using the apparatus of the present invention versus the process of using the apparatus of Nygren, notwithstanding the fact that the structural limitations of the apparatus of Nygren reads on the claimed structural limitations of applicant's invention. The flexible hoses of Nygren include an end portion, even though it's connectible to a paint spray gun, reads on the broadly claimed "nozzle aligned...such that an internal channel in the object is flushed with cleaning fluids". It is further noted that how the nozzle is "aligned" and whether or not the object to be cleaned is "disassembled" is intended use and given little patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) Moreover, Applicant's "whereby" clause in claim 1 is considered intended use since the clause recites the operation of the apparatus and fails to further structurally limit

the claimed apparatus. It has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

In addition, applicant argues that the holding devices are "designed to hold removable components of the sprayer body". This is not persuasive because applicant's arguments are not directed to the broadly claimed subject matter, namely "holding devices", but rather to intended use of how and what the holding device holds (*i.e.* "for holding..." and "used to hold..."). Moreover, applicant's limitations of whether the "objects" are "disassembled" or "assembled" are directed to the work being worked upon by the apparatus and have no effect on the apparatus. MPEP 2115 and caselaw is replete with teachings disclosing that expressions relating an apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Accordingly, since Nygren discloses each and every structural limitation of applicant's claimed invention, and the structural limitations of Nygren are fully capable of performing the intended use recitations of the claimed invention, Nygren reads on applicant's claimed apparatus.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The phrase “designed to hold specific components” renders the claims vague and indefinite. How are the “designed”? What components are “specific”? Using such relative terms renders the claim indefinite because such language fails to define the meets and bounds of patent protection sought. Any holding device is inherently “designed to hold” a component and any component is “specific”. Clarification and correction are required.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1-9 & 16-26 are rejected under 35 U.S.C. 102(b) as being anticipated US 5,937,875 by Nygren.

Re claims 1-3, 18, Nygren discloses an apparatus having a basin 110, a plurality of supply nozzles (nozzles 74 & 76) connected to a supply line 60, a plurality of holding devices (clips 98 connected to removable rack 20), a plurality

of cleaning nozzles attached to a plurality of flexible extension tubes (which are connected to the supply line), the flexible tubes being construed as adjustable tubes (cleaning nozzles being end adapters 82/84 located on flexible tubes 78 which are aligned with the holding device via connection to the object to be held) (see entire reference of Nygren, specifically Figure 2; col. 2, lines 30-46; col. 3, lines 10-25).

It is noted that how the flexible extension tubes are adjustably aligned is considered intended use and given little patentable weight in apparatus claims. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) Moreover, Applicant's "whereby" clause in claim 1 is considered intended use since the clause recites the operation of the apparatus and fails to further structurally limit the claimed apparatus. It has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Re independent claim 4, Applicant claims a "kit". It is noted that the recitation of "for attachment to cleaning machines" in independent claim 4 has not been given significant patentable weight because the recitation occurs in the preamble. A preamble is generally accorded little patentable weight where it

merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is further noted that Merriam-Webster (<http://www.merriamwebster.com>) defines of a kit as being “a group of persons or things”, and thus, claims 4-5 and 7-9 will be examined accordingly.

Re claims 4-6 & 8-9, Nygren discloses a group of structures including a plurality of holding devices (clips 98 connected to removable rack 20), a plurality of cleaning nozzles attached to a plurality of flexible extension tubes which are fed from solvent supply (manifold 60), the flexible extension tubes being equivalent to means to adjustably align (cleaning nozzles being end adapters 82/84 located on flexible tubes 78 which are aligned with the holding device via connection to the object to be held) (see entire reference of Nygren, specifically Figure 2; col. 2, lines 30-46; col. 3, lines 10-25).

As previously noted, the recitations of how the flexible extension tubes are adjustably aligned, and furthermore whether or not flow direction “can be altered” is considered intended use and given little patentable weight in apparatus claims.

Re claims 7, 16-17 & 19-22, Nygren discloses a plurality of brackets (see support rack 20 having four vertical members 50 and horizontal members 52/54/52 and posts 56, Figures 2 & 3) attached which, in view of the Figures 2 &



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3, inherently must attach to the solvent supply 60 and, as a result, also connected to extension tubes 78 with cleaning nozzles due to the interwoven relationship between solvent supply manifold 60 and support rack 20 including vertical members 50, horizontal members 52/54 and ring members 46/48.

Re claims 23-26, the holding devices of Nygren read on applicant's holding devices "designed to hold specific components" since the components in Nygren are "specific".

Accordingly, recitation of Nygren reads on applicant's claimed invention.

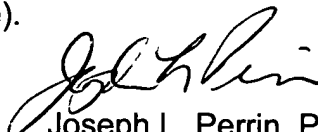
### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joseph L. Perrin, Ph.D.  
Examiner  
Art Unit 1746

jlp